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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/714,544	LORENZ, RICHARD
		Examiner	Art Unit	
		Mitra Tashakkori	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 November 2003_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-30_ is/are rejected.

7)☒ Claim(s) _8,9,13,18,19,28 and 29_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _14 November 2003_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _06/24/2004, 01/18/2005_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

This is in response to application filed on November 14, 2003, in which claims 1-30 are

presented for examination.

Status of Claims

Claims 1-30 are pending, of which claims 1, 11, and 21 are in independent form.

Information Disclosure Statement

1.   The information disclosure statement filed 01/18/2005 fails to comply with 37 CFR

1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent

literature publication or that portion which caused it to be listed; and all other information or

that portion which caused it to be listed. Document WO 02/25464 A1 was cited on the IDS but

was not provided. Therefore, the IDS has been placed in the application file, but the missing

information referred to therein has not been considered.

Drawings

2.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the feature of deleting stored

messages after a predetermined period of time, as claimed in claims 10, 20, and 30, must be

shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the

Office action to avoid abandonment of the application. Any amended replacement drawing sheet

should include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing should

not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must

be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

3.   The drawings are objected to under 37 CFR 1.83(a) because they fail to show that if no

valid response is received when a confirmation email is sent to the sender, the email is stored for

a predefined period of time, then deleted, as described in the specification (pg. 10, paragraph

[0034]). Any structural detail that is essential for a proper understanding of the disclosed

invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment

of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a

drawing figure is to be canceled, the appropriate figure must be removed from the replacement

sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining

figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 100, 112, 114, 116 and 118. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 122, 124, 126 and 128. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either

"Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6.   The drawings are objected to because, in Figure 2, the arrow indicating a "yes" at step 215 does not point to step 255, as is described in the specification, but rather to the "yes" arrow at step 220. Furthermore, the "yes" arrow of step 215 joins the output of step 220 before the word "yes" appears to identify the output of step 220, which incorrectly implies that the "yes" output of step 215 in some way affects, or is affected by, the "yes" output of step 220. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7.   Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

8.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9.   The abstract of the disclosure is objected to because there is no heading to identify the

abstract as such, and instead the title of the application is repeated twice. As provided in 37 CFR

1.72(b), the abstract should follow the heading "Abstract" or "Abstract of the Disclosure." In

addition, the content of the abstract is improper, as it begins by merely repeating the title, as an

incomplete sentence, followed by a single sentence vaguely and broadly describing one

embodiment of the invention. Correction is required. See MPEP § 608.01(b).

10.   The disclosure is objected to because of the following informalities:

     a.   The phrase "may vary for particular" is grammatically incorrect (page 6, line 8);

     b.   There is inadequate discussion of what happens if the questions asked at each

        step of Figure 2 is answered with a "no" though clearly depicted by the drawing.

        Further, the description of each step is written in such a way to imply the

        reference numbers should correspond with the "yes" line, as opposed to the

        question blocks themselves, as is depicted in the drawing; and

     c.   The content of the Brief Summary is not proper. See MPEP § 608.01(d).

Appropriate correction is required.

Claim Objections

11.   Claims 8, 9 and 13 are objected to because of the following informalities:

     d.   The criteria an image must meet to be considered "obscured" has not been set

        forth (claim 8, line 2);

- The criteria for "non-machine-readable" has not been set forth (claim 9, line 2) and it is not even clear whether this means the intro-word is sent to the sender via some electronic means, or on non-machine-readable paper, for example;

- The phrase "means for comprising delivering" is incorrect (claim 13, line 2); and

- The word "internet" should be capitalized if it is referring to the widely used Internet backbone using TCP/IP protocol (claim 7, line 3; claim 17, line 4; claim 27, line 4).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

12.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13.   Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14.   Claim 21 recites "***A computer program product tangibly embodied in a machine-readable medium, comprising: instructions for...***" which is functional descriptive material, or software, per se. The breadth of the term "machine-readable medium" includes signals and carrier waves, which are not tangible mediums, and are therefore non-statutory. Functional descriptive material, when encoded on a computer-readable medium that falls in one of the statutory categories and employed as a computer component, becomes structurally and functionally interrelated to the medium, therefore also becoming statutory.

15.   Claims 22-30 depend on claim 21, and are rejected on the same grounds.

Claim Rejections - 35 USC § 112

16.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17.   Claims 1-9, 13-19, and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18.   As per claim 1, it is unclear how the objective of the method as set forth by the preamble, *"for filtering electronic mail,"* is achieved by the steps recited in the body of the claim. More specifically, it is unclear how *"receiving, in a data processing system, an electronic mail message; determining if the electronic mail message includes an intro-word; delivering the electronic mail message if the electronic mail message includes the intro-word; and storing the electronic mail message if the electronic mail message does not include the intro-word"* effectively "filters" electronic mail.

19.   Claims 2-9 depend on claim 1, and are therefore rejected on the same grounds.

20.   Furthermore, as per claim 3, the use of the term "if" renders the claim vague and indefinite because there is no indication of what step is taken when the condition is *not* met.

Unlike claim 1, which clearly states that the message is delivered "*if the electronic mail message includes the intro-word*" (line 6) and that the message is stored "*if the electronic mail message does not include the intro-word*" (line 9), claim 3 only recites "*delivering the electronic mail message if the email address of a sender of the electronic mail message is on an authorized sender list.*" Further, there is no indication of which step or steps recited in claim 1 are to precede the step defined by claim 3. Therefore, it is not clear whether a message can include the intro-word and also be sent from an authorized sender, nor is it clear whether the message can first be stored because it lacks the intro-word, then be delivered because it was sent by an authorized sender. It is not clear whether a message is only to be stored if it is not delivered. It is not clear what the scope of the claim is in cases where the message has already been delivered because it included the intro-word.

21.   Furthermore, as per claim 4, the use of the term "if" renders the claim vague and indefinite because there is no indication of what step is taken when the condition is *not* met. Unlike claim 1, which clearly states that the message is delivered "*if the electronic mail message includes the intro-word*" (line 6) and that the message is stored "*if the electronic mail message does not include the intro-word*" (line 9), claim 4 only recites "*delivering the electronic mail message if the domain name of a sender of the electronic mail message is on an authorized domain list.*" Further, there is no indication of which step or steps recited in claim 1 are to precede the step defined by claim 4. Therefore, it is not clear whether a message can include the intro-word and also be sent from an authorized domain, nor is it clear whether the message can first be stored because it lacks the intro-word, then be delivered because it was sent from an authorized domain. It is not clear whether a message is only to be stored if it is not delivered. It is not clear what the scope of the claim is in cases where the message has already been delivered because it included the intro-word.

22.   Furthermore, as per claim 5, the use of the term "if" renders the claim vague and

indefinite because there is no indication of what step is taken when the condition is *not* met.

Claim 5 recites "*if the electronic mail message does not include the intro-word*" (line 1),

which makes the scope of the claim unclear in cases where the message has already been

delivered because it included the intro-word.

23.   Furthermore, claims 6-9 directly depend on claim 5, and are therefore rejected on the

same grounds as claim 5.

24.   As per claim 11, the use of the term "if" renders the claim vague and indefinite because,

by introducing a conditional phrase when defining a system or product, the metes and bounds of

that system or product become indeterminable. The language of the claim is such that one

skilled in the art would not know, with any reasonable certainty, how to avoid infringing the

scope of the claim; therefore, the claim is considered indefinite.

25.   Claims 12-19 depend on claim 11, and are therefore rejected on the same grounds.

26.   Furthermore, claims 13-17 introduce additional "if" statements that must also be

corrected, for the reasons stated in the rejection of claim 11.

27.   As per claim 21, the use of the term "if" renders the claim vague and indefinite because,

by introducing a conditional phrase when defining a system or product, the metes and bounds of

that system or product become indeterminable. The language of the claim is such that one

skilled in the art would not know, with any reasonable certainty, how to avoid infringing the

scope of the claim; therefore, the claim is considered indefinite.

28.   Claims 22-29 depend on claim 21, and are therefore rejected on the same grounds.

29.   Furthermore, claims 23-27 introduce additional "if" statements that must also be

corrected, for the reasons stated in the rejection of claim 21.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

30.   Claims 1-4, 11-14, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by

Paul US 6,112,227 (hereinafter referred to as Paul), published on December 7, 1999.

31.   As per claim 1, Paul discloses "*A method for filtering electronic mail*" as a method and

system for filtering electronic mail (col. 1, line 7; col. 8, line 13). In addition, Paul discloses

"*receiving, in a data processing system, an electronic mail message*" as the step of

receiving an electronic mail message (col. 2, line 25), at the mail server in some embodiments

and at the client system in others (col. 8, line 19). Paul also discloses "*determining if the*

electronic mail message includes an intro-word" as the extraction of data from specific fields

of the received message, which is then compared to stored data to determine if the received

message contains a match (col. 1, line 10; col. 2, line 26; col. 8, line 23). The stored data is

identification data used to determine the status of incoming mail messages (col. 3, line 31). Paul

discloses "*delivering the electronic mail message if the electronic mail message includes the intro-word*" as the process of marking an incoming message as acceptable upon determination that its data matches the stored inclusion data (col. 3, line 66; col. 7, line 29; col. 8, line 27), which is then followed by forwarding the message to the recipient's inbox (col. 1, 15; col. 4, line 9; col. 7, line 36). Paul also discloses "*storing the electronic mail message if the electronic mail message does not include the intro-word*" as the marking of an incoming mail message with no matching data as distinct from messages whose fields included data that matched stored inclusion data (col. 4, line 21; col. 7, line 39). Incoming emails are handled according to the mark they receive (col. 1, line 19; col. 4, line 26; col. 9, line 8), and may be stored in different folders (col. 9, line 16). Further, incoming emails may be filtered before being stored (col. 6, line 54; col. 7, line 63) by the mail server (col. 7, line 6), and messages that did not match any stored inclusion data may not be displayed to the recipient (col. 9, line 5).

32.   As per claim 2, Paul discloses "*The method of claim 1, wherein the intro-word is located in a subject line of the electronic mail message*" as one of the fields that may be checked against the inclusion data discussed in claim 1 (col. 3, line 56; col. 8, line 37). It is possible for senders to ensure their emails pass through the filter unhindered by including specific, predefined words in the subject line (col. 5, line 65). The subject line may be searched by keyword (col. 6, line 6).

33.   As per claim 3, Paul discloses "*The method of claim 1, further comprising delivering the electronic mail message if the email address of a sender of the electronic mail message is on an authorized sender list*" as another field that may be checked against the inclusion data discussed in claim 1 (col. 1, line 13; col. 3, line 5; col. 8, line 37). As has already been discussed, messages that match the stored inclusion data are marked as acceptable and

then forwarded to the recipient's inbox (col. 1, line 19; col. 3, line 66; col. 4, line 26; col. 7, line 29; col. 8, line 27; col. 9, line 8).

34.   As per claim 4, Paul discloses *"The method of claim 1, further comprising delivering the electronic mail message if the domain name of a sender of the electronic mail message is on an authorized domain list"* as another criteria by which incoming emails may be sorted, to separate desired and undesired messages (col. 1, line 13). If the initial field comparisons that were discussed in claims 1-3 did not result in a match of the stored inclusion data, a heuristic evaluation to see if the sender's domain name matches the stored inclusion data is performed, which indicates the message is of interest to the recipient (col. 4, line 14; col. 9, line 44). The message is then displayed to the recipient (col. 2, line 43; col. 3, line 49).

35.   As per claim 11, Paul discloses *"A data processing system having at least a processor and accessible memory"* as a system for filtering email which includes a processor and storage space (col. 2, line 51). Further, the system may be implemented as software (col. 3, line 24), which inherently requires a computing system with processing capabilities. Paul discloses *"means for receiving, in the data processing system, an electronic mail message"* as a function of an email server (col. 7, line 5). Paul discloses *"means for determining if the electronic mail message includes an intro-word"* as the functionality of retrieving data from specific fields of the incoming message and comparing them to the stored inclusion data to determine if the incoming message data matches (col. 1, line 10; col. 2, line 26; col. 8, line 23), where the comparison may be done by performing a text or keyword search (col. 6, line 8). Paul discloses *"means for delivering the electronic mail message if the electronic mail message includes the intro-word"* as another function of the email server, which forwards the filtered email to the recipient terminal (col. 7, line 25). As discussed in the analysis of claim 1, incoming

messages are marked as acceptable upon determination that its data matches the stored

inclusion data (col. 3, line 66; col. 7, line 29; col. 8, line 27), which is then followed by

forwarding the message to the recipient's inbox (col. 1, 15; col. 4, line 9; col. 7, line 36). Paul

discloses "*means for storing the electronic mail message if the electronic mail message*

does not include the intro-word" as the marking of an incoming mail message with no

matching data as distinct from messages whose fields included data that matched stored

inclusion data (col. 4, line 21; col. 7, line 39). Incoming emails are handled according to the

mark they receive (col. 1, line 19; col. 4, line 26; col. 9, line 8), and may be stored in different

folders (col. 9, line 16). Further, incoming emails may be filtered before being stored (col. 6, line

54; col. 7, line 63) by the mail server (col. 7, line 6), and messages that did not match any stored

inclusion data may not be displayed to the recipient (col. 9, line 5).

36.   As per claim 12, Paul discloses "*The data processing system of claim 11, wherein the*

intro-word is located in a subject line of the electronic mail message" as one of the fields

that may be checked against the inclusion data discussed in claim 1 (col. 3, line 56; col. 8, line

37). It is possible for senders to ensure their emails pass through the filter unhindered by

including specific, predefined words in the subject line (col. 5, line 65). The subject line may be

searched by keyword (col. 6, line 6).

37.   As per claim 13, Paul discloses "*The data processing system of claim 11, further*

means for comprising delivering the electronic mail message if the email address of a

sender of the electronic mail message is on an authorized sender list" as another field that

may be checked against the inclusion data discussed in claim 1 (col. 1, line 13; col. 3, line 5; col.

8, line 37). As has already been discussed, messages that match the stored inclusion data are

marked as acceptable and then forwarded to the recipient's inbox (col. 1, line 19; col. 3, line 66;

col. 4, line 26; col. 7, line 29; col. 8, line 27; col. 9, line 8).

38.   As per claim 14, Paul discloses *"The data processing system of claim 11, further*

comprising means for delivering the electronic mail message if the domain name of a

sender of the electronic mail message is on an authorized domain list" as another criteria

by which incoming emails may be sorted, to separate desired and undesired messages (col. 1,

line 13). If the initial field comparisons that were discussed in claims 1-3 did not result in a

match of the stored inclusion data, a heuristic evaluation to see if the sender's domain name

matches the stored inclusion data is performed, which indicates the message is of interest to the

recipient (col. 4, line 14; col. 9, line 44). The message is then displayed to the recipient (col. 2,

line 43; col. 3, line 49).

39.   As per claim 21, Paul discloses *"A computer program product tangibly embodied in*

machine-readable medium" as a system that may be implemented as hardware, software or a

combination of both (col. 3, line 24). One of ordinary skill in the art would recognize that

software is inherently a set of instructions for performing various functions; therefore, the

features and functionality of the email filtering system disclosed by Paul inherently discloses the

instructions for performing those functions. Thus, Paul discloses *"instructions for receiving,*

in a data processing system, an electronic mail message" as a function of the filtering

system, which receives incoming email messages (col. 2, line 25), at the mail server in some

embodiments and at the client system in others (col. 8, line 19). Paul also discloses

"instructions for determining if the electronic mail message includes an intro-word" as

the extraction of data from specific fields of the received message, which is then compared to

stored data to determine if the received message contains a match (col. 1, line 10; col. 2, line 26;

col. 8, line 23). The stored data is identification data used to determine the status of incoming

mail messages (col. 3, line 31). Paul discloses *"instructions for delivering the electronic mail*

message if the electronic mail message includes the intro-word" as the marking of an

incoming message as acceptable upon determination that its data matches the stored inclusion

data (col. 3, line 66; col. 7, line 29; col. 8, line 27), which is then followed by forwarding the

message to the recipient's inbox (col. 1, 15; col. 4, line 9; col. 7, line 36). Paul also discloses *"and*

instructions for storing the electronic mail message if the electronic mail message does

not include the intro-word" as the marking of an incoming mail message with no matching

data as distinct from messages whose fields included data that matched stored inclusion data

(col. 4, line 21; col. 7, line 39). Incoming emails are handled according to the mark they receive

(col. 1, line 19; col. 4, line 26; col. 9, line 8), and may be stored in different folders (col. 9, line

16). Further, incoming emails may be filtered before being stored (col. 6, line 54; col. 7, line 63)

by the mail server (col. 7, line 6), and messages that did not match any stored inclusion data

may not be displayed to the recipient (col. 9, line 5).

40.   As per claim 22, Paul discloses *"The computer program product of claim 21, wherein*

the intro-word is located in a subject line of the electronic mail message" as one of the

fields that may be checked against the inclusion data discussed in claim 1 (col. 3, line 56; col. 8,

line 37). It is possible for senders to ensure their emails pass through the filter unhindered by

including specific, predefined words in the subject line (col. 5, line 65). The subject line may be

searched by keyword (col. 6, line 6).

41.   As per claim 23, Paul discloses *"The computer program product of claim 21, further*

comprising instructions for delivering the electronic mail message if the email address of

a sender of the electronic mail message is on an authorized sender list" as another field

that may be checked against the inclusion data discussed in claim 1 (col. 1, line 13; col. 3, line 5; col. 8, line 37). As has already been discussed, messages that match the stored inclusion data are marked as acceptable and then forwarded to the recipient's inbox (col. 1, line 19; col. 3, line 66; col. 4, line 26; col. 7, line 29; col. 8, line 27; col. 9, line 8).

42.   As per claim 24, Paul discloses "***The computer program product of claim 21, further comprising instructions for delivering the electronic mail message if the domain name of a sender of the electronic mail message is on an authorized domain list***" as another criteria by which incoming emails may be sorted, to separate desired and undesired messages (col. 1, line 13). If the initial field comparisons that were discussed in claims 1-3 did not result in a match of the stored inclusion data, a heuristic evaluation to see if the sender's domain name matches the stored inclusion data is performed, which indicates the message is of interest to the recipient (col. 4, line 14; col. 9, line 44). The message is then displayed to the recipient (col. 2, line 43; col. 3, line 49).

Claim Rejections - 35 USC § 103

43.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

44.   Claims 5-10, 15-20 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Heiner US 6112227 (hereinafter referred to as Heiner).

45.   As per claim 5, Paul discloses *"The method of claim 1, further comprising, if the electronic mail message does not include the intro-word"* as was discussed above in the analysis of claim 1. However, Paul is silent on sending an email to an unconfirmed sender. Nevertheless, Heiner discloses *"then sending a confirmation message to the sender of the electronic mail message"* as holding an incoming message and sending an email to the sender to request that they complete a registration process, in cases where the sender's email address was not found on the accept list (Heiner: col. 2, line 20; col. 3, line 39; col. 3, line 47). It would be obvious to one skilled in the art to modify Paul to include a registration process as part of the "further processing" done on an incoming email when there is no match was found using the initial field checks (Paul: col. 4, line 13), where the motivation for such a modification is also disclosed by Heiner: "One advantage of including such a registration is that it requires the source client to make an effort to filter-in a desired message, instead of requiring the destination client to filter-out undesired messages" (Heiner: col. 4, line 9).

46.   As per claim 6, Paul in view of Heiner, as explained above, discloses *"The method of claim 5"* as was discussed above in the analysis of claim 5. In addition, Heiner discloses *"receiving a response mail message corresponding to the confirmation message"* as the monitoring of the response of the sender to determine if a proper response was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line 64), where a proper response comes in the form of a reply email (Heiner: col. 3, line 47; col. 3, line 61). Heiner also discloses *"delivering the electronic mail message if the response mail message includes the intro-word"* as sending the original email to the recipient only if the registration process was completed successfully (Heiner: col. 2, line 27; col. 3, line 48). Heiner discloses *"storing the electronic*

mail message if the response mail message does not include the intro-word" as storing the

original message in memory if no proper response was received (Heiner: col. 4, line 32).

47.   As per claim 7, Paul in view of Heiner, as explained above, discloses *"The method of*

claim 5" as was discussed above in the analysis of claim 5. In addition, Heiner discloses

"receiving a response corresponding to the confirmation message via an internet

connection" as the monitoring of the response of the sender to determine if a proper response

was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line 64), where a proper response

comes in the form of filling out a form on an Internet web page (Heiner: col. 4, line 4; col. 3, line

61). Heiner also discloses *"delivering the electronic mail message if the response includes*

the intro-word" as sending the original email to the recipient only if the registration process

was completed successfully (Heiner: col. 2, line 27; col. 3, line 48). Heiner discloses *"and*

storing the electronic mail message if the response does not include the intro-word" as

storing the original message in memory if no proper response was received (Heiner: col. 4, line

32).

48.   As per claim 8, Paul in view of Heiner, as explained above, discloses *"The method of*

claim 5" as was discussed above in the analysis of claim 5. Heiner also discloses *"sending an*

obscured image of the intro-word to the sender" as making the registration process more

complex by requiring the following of instructions that can only be followed by a human as a

component of a proper response, to thwart robotic spam programs (Heiner: col. 3, line 56; col.

3, line 59). Furthermore, the examiner is taking Official Notice that it is well known in the art

that one mechanism for requiring a human to process registration instructions to prevent spam

is to use text distortion technology such as CAPTCHA, which stands for Completely Automated

Turing Test To Tell Computers and Humans Apart. CAPTCHA technology uses text that has

been distorted in some way such that computers cannot render the text using optical character

recognition (OCR) technology, while still being readable by humans.

49.   As per claim 9, Paul in view of Heiner, as explained above, discloses *"The method of*

claim 5" as was discussed above in the analysis of claim 5. Heiner also discloses *"further*

comprising sending the intro-word to the sender in a non-machine-readable form" as

making the registration process more complex by requiring the following of instructions that

can only be followed by a human as a component of a proper response, to thwart robotic spam

programs (Heiner: col. 3, line 56; col. 3, line 59).

50.   As per claim 10, Paul discloses *"The method of claim 1"* as was discussed above in the

analysis of claim 1. However, Paul is silent on deleting the stored messages after some time.

Nevertheless, Heiner discloses *"further comprising deleting the stored electronic mail*

message after a predetermined amount of time" as deleting the messages that have not been

properly responded to after some predetermined amount of time (Heiner: col. 4, line 47).

51.   As per claim 15, Paul discloses *"The data processing system of claim 11"* as was

discussed above in the analysis of claim 11. However, Paul is silent on sending an email to an

unconfirmed sender. Nevertheless, Heiner discloses *", further comprising means for sending*

a confirmation message to the sender of the electronic mail message if the electronic mail

message does not include the intro-word" as holding an incoming message and sending an

email to the sender to request that they complete a registration process, in cases where the

sender's email address was not found on the accept list (Heiner: col. 2, line 20; col. 3, line 39;

col. 3, line 47). It would be obvious to one skilled in the art to modify Paul to include a

registration process as part of the "further processing" done on an incoming email when there is

no match was found using the initial field checks (Paul: col. 4, line 13), where the motivation for

such a modification is also disclosed by Heiner: "One advantage of including such a registration

is that it requires the source client to make an effort to filter-in a desired message, instead of

requiring the destination client to filter-out undesired messages" (Heiner: col. 4, line 9).

52.   As per claim 16, Paul in view of Heiner, as explained above, discloses *"The data*

processing system of claim 15" as was discussed above in the analysis of claim 15. In addition,

Heiner discloses *"means for receiving a response mail message corresponding to the*

confirmation message" as the monitoring of the response of the sender to determine if a

proper response was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line 64), where a

proper response comes in the form of a reply email (Heiner: col. 3, line 47; col. 3, line 61).

Heiner also discloses *"means for delivering the electronic mail message if the response*

mail message includes the intro-word" as sending the original email to the recipient only if

the registration process was completed successfully (Heiner: col. 2, line 27; col. 3, line 48).

Heiner discloses *"means for storing the electronic mail message if the response mail*

message does not include the intro-word" as storing the original message in memory if no

proper response was received (Heiner: col. 4, line 32).

53.   As per claim 17, Paul in view of Heiner, as explained above, discloses *"The data*

processing system of claim 15" as was discussed above in the analysis of claim 15. In addition,

Heiner discloses *"means for receiving a response corresponding to the confirmation*

message via an internet connection" as the monitoring of the response of the sender to

determine if a proper response was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line

64), where a proper response comes in the form of filling out a form on an Internet web page

(Heiner: col. 4, line 4; col. 3, line 61). Heiner also discloses *"means for delivering the*

electronic mail message if the response includes the intro-word" as sending the original

email to the recipient only if the registration process was completed successfully (Heiner: col. 2,

line 27; col. 3, line 48). Heiner discloses *"means for storing the electronic mail message if*

the response does not include the intro-word" as storing the original message in memory if

no proper response was received (Heiner: col. 4, line 32).

54.   As per claim 18, Paul in view of Heiner, as explained above, discloses *"The data*

processing system of claim 15" as was discussed above in the analysis of claim 15. Heiner also

discloses *"means for sending an obscured image of the intro-word to the sender"* as making

the registration process more complex by requiring the following of instructions that can only be

followed by a human as a component of a proper response, to thwart robotic spam programs

(Heiner: col. 3, line 56; col. 3, line 59). Furthermore, the examiner is taking Official Notice that

it is well known in the art that one mechanism for requiring a human to process registration

instructions to prevent spam is to use CAPTCHA technology, which stands for Completely

Automated Turing Test To Tell Computers and Humans Apart. CAPTCHA technology uses text

that has been distorted in some way such that computers cannot render the text using optical

character recognition (OCR) technology, while still being readable by humans.

55.   As per claim 19, Paul in view of Heiner, as explained above, discloses *"The data*

processing system of claim 15" as was discussed above in the analysis of claim 15. Heiner also

discloses *"means for sending the intro-word to the3 sender in a non-machine-readable*

form" as making the registration process more complex by requiring the following of

instructions that can only be followed by a human as a component of a proper response, to

thwart robotic spam programs (Heiner: col. 3, line 56; col. 3, line 59).

56.   As per claim 20, Paul discloses *"The data processing system of claim 11"* as was

discussed above in the analysis of claim 11. However, Paul is silent on deleting the stored

messages after some time. Nevertheless, Heiner discloses *"means for deleting the stored*

electronic mail message after a predetermined amount of time" as deleting the messages

that have not been properly responded to after some predetermined amount of time (Heiner:

col. 4, line 47).

57.   As per claim 25, Paul discloses *"The computer program product of claim 21"* as was

discussed above in the analysis of claim 21. However, Paul is silent on sending an email to an

unconfirmed sender. Nevertheless, Heiner discloses *"instructions for sending a confirmation*

message to the sender of the electronic mail message if the electronic mail message does

not include the intro-word" as holding an incoming message and sending an email to the

sender to request that they complete a registration process, in cases where the sender's email

address was not found on the accept list (Heiner: col. 2, line 20; col. 3, line 39; col. 3, line 47). It

would be obvious to one skilled in the art to modify Paul to include a registration process as part

of the "further processing" done on an incoming email when there is no match was found using

the initial field checks (Paul: col. 4, line 13), where the motivation for such a modification is also

disclosed by Heiner: "One advantage of including such a registration is that it requires the

source client to make an effort to filter-in a desired message, instead of requiring the destination

client to filter-out undesired messages" (Heiner: col. 4, line 9).

58.   As per claim 26, Paul in view of Heiner, as explained above, discloses *"The computer*

program product of claim 25" as was discussed above in the analysis of claim 25. In addition,

Heiner discloses *"instructions for receiving a response mail message corresponding to the*

confirmation message" as the monitoring of the response of the sender to determine if a

proper response was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line 64), where a

proper response comes in the form of a reply email (Heiner: col. 3, line 47; col. 3, line 61).

Heiner also discloses "*instructions for delivering the electronic mail message if the*

response mail message includes the intro-word" as sending the original email to the

recipient only if the registration process was completed successfully (Heiner: col. 2, line 27; col.

3, line 48). Heiner discloses "*instructions for storing the electronic mail message if the*

response mail message does not include the intro-word" as storing the original message in

memory if no proper response was received (Heiner: col. 4, line 32).

59.   As per claim 27, Paul in view of Heiner, as explained above, discloses "*The computer*

program product of claim 25" as was discussed above in the analysis of claim 25. In addition,

Heiner discloses "*instructions for receiving a response corresponding to the confirmation*

message via an internet connection" as the monitoring of the response of the sender to

determine if a proper response was received (Heiner: col. 2, line 24; col. 3, line 45; col. 3, line

64), where a proper response comes in the form of filling out a form on an Internet web page

(Heiner: col. 4, line 4; col. 3, line 61). Heiner also discloses "*instructions for delivering the*

electronic mail message if the response includes the intro-word" as sending the original

email to the recipient only if the registration process was completed successfully (Heiner: col. 2,

line 27; col. 3, line 48). Heiner discloses "*instructions for storing the electronic mail*

message if the response does not include the intro-word" as storing the original message in

memory if no proper response was received (Heiner: col. 4, line 32).

60.   As per claim 28, Paul in view of Heiner, as explained above, discloses "*The computer*

program product of claim 25" as was discussed above in the analysis of claim 25. Heiner also

discloses "*instructions for sending an obscured image of the intro-word to the sender*" as

making the registration process more complex by requiring the following of instructions that can only be followed by a human as a component of a proper response, to thwart robotic spam programs (Heiner: col. 3, line 56; col. 3, line 59). Furthermore, the examiner is taking Official Notice that it is well known in the art that one mechanism for requiring a human to process registration instructions to prevent spam is to use CAPTCHA technology, which stands for Completely Automated Turing Test To Tell Computers and Humans Apart. CAPTCHA technology uses text that has been distorted in some way such that computers cannot render the text using optical character recognition (OCR) technology, while still being readable by humans.

61.   As per claim 29, Paul in view of Heiner, as explained above, discloses "*The computer program product of claim 25*" as was discussed above in the analysis of claim 25. Heiner also discloses "*instructions for sending the intro-word to the sender in a non-machine-readable form*" as making the registration process more complex by requiring the following of instructions that can only be followed by a human as a component of a proper response, to thwart robotic spam programs (Heiner: col. 3, line 56; col. 3, line 59).

62.   As per claim 30, Paul discloses "*The computer program product of claim 21*" as was discussed above in the analysis of claim 21. However, Paul is silent on deleting the stored messages after some time. Nevertheless, Heiner discloses "*instructions for deleting the stored electronic mail message after a predetermined amount of time*" as deleting the messages that have not been properly responded to after some predetermined amount of time (Heiner: col. 4, line 47).

Conclusion

63.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Tashakkori whose telephone number is 571-272-9069. The examiner can normally be reached on Mon-Thurs 8:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on 571-272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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